

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit: 2826
Examiner: Williams, Alexander O.

IN RE THE APPLICATION OF:

INVENTORS: NEUHAUS et al.

APPLICATION NO.: 09/957,401

FILING DATE: 19 September 2001

TITLE: METHOD FOR ASSEMBLING COMPONENTS AND
ANTENNAE IN RADIO FREQUENCY IDENTIFICATION
DEVICES



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RESPONSE TO SECOND RESTRICTION REQUIREMENT

Box Non-Fee Amendment
Commissioner for Patents
U.S. Patent and Trademark Office
Washington, D.C. 20231

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Date of Deposit: 12 April 2002

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Signature:

Name: Kristi Murray

Sir:

This letter is in response to an Office action dated 29 January 2002 wherein restriction of the claims under 35 U.S.C. § 121 is required.

Initially, Applicant notes that the serial number and applicant information on the Office Action Summary page and the serial number on the Detailed Action page are incorrect. A copy of the Office Action Summary page with corrections highlighted is enclosed. Although the application references are incorrect, the substance of the Office action does relate to the instant application and Applicant is therefore filing this substantive response to expedite the prosecution procedure.

The Office action advocates the position that the claims presently under consideration in the application are directed to five patentably distinct inventions, apparently based upon a

review of the drawings:

Species I Figures 2-8B;
Species II Figures 9A-9D;
Species III Figures 9E, 9F, 9G, and 10;
Species IV Figures 11A-11D; and
Species V Figures 12A-12D.

Applicant traverses the species designation of Species I. The Figures 2-8B are, in fact, a generic representation of the central invention. The generic nature of these figures becomes apparent when the figures are coupled with their description in the specification, for example, at pages 17-18. Therefore, every claim in the application may actually be read on Figures 2-8B and a designation of a species with respect to these figures may be improper.

Applicant further traverses the contention that currently no claims are generic to all of the species. Applicant contends that, in fact, claims 26-29, 39-45, 67-71, and 75-82 may each be generic to all the species identified in the Office action.

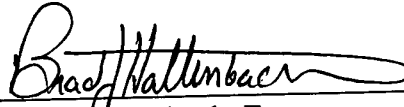
Further, Applicant disagrees that there is a patentably distinct difference between Species IV and Species V and traverses the contention of the same in the Office action. Figures 12A-12D identified as Species V merely show different configurations of antennae for use with the smart inlay components shown in Figures 11A-11D classified as Species IV. This should be more apparent when Figures 12A-12D are viewed in light of the written description at page 28, line 4 through page 30, line 13.

Pursuant to 37 C.F. R. § 1.142, Applicants elect for prosecution claims directed to Species IV, without waiving the right to reinstatement of the non-elected claims of Species I, II, III, and V of Group I and of Group II at a later time. The Office action requested that Applicant identify the claims that read on the species elected for further prosecution by Applicant. This listing is set forth as follows:

Species IV - Claims 26-29, 34-48, 66-82, 84, and 85.

Again, Applicant requests the reconsideration of the classification of Species V and that Species IV and V as identified in the Office action be combined for further prosecution.

Respectfully submitted this 12th day of April 2002.



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Docketing

Office Action Summary

APR 12 2002

Application No.

09/957,440 09/957,401

Applicant(s)

NEUHAUS, HERBERT ET AL.
MAEGAWA, HIROTOSHI

Examiner

Alexander O Williams

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-93 is/are pending in the application.
- 4a) Of the above claim(s) 1-25, 49-65 and 86-93 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-93 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's Amendment/Election of Group I in Paper # 3, filed 2/26/02, has been acknowledged.

This application contains claims 1-25, 49-65 and 86-93 drawn to an invention non-elected without traverse in Paper No. 4.

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I, figures 2-8B

Species II, figures 9A-9D

Species III, figures 9E, 9F, 9G and 10

Species IV, figures 11A-11D and

Species V, figures 12A-12D.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander O Williams whose telephone number is (703) 308 4863. The examiner can normally be reached on M-F 6:30-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (703) 308 6601. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308 7722 for regular communications and (703) 308 7724 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 0956.

AOW
March 12, 2002





Alexander Williams

Primary Examiner

04-15-02

2826

CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)			Docket No. 5542.02
Applicant(s): NEUHAUS et al.			
Serial No. 09/957,401	Filing Date 09/19/01	Examiner Alexander Williams	Group Art Unit 2826
Invention: METHOD FOR ASSEMBLING COMPONENTS AND ANTENNAE IN RADIO FREQUENCY IDENTIFICATION DEVICES			
			
I hereby certify that the following correspondence:			
Response to Second Restriction Requirement; Corrected (highlighted) Office Action Summary pages; Return Acknowledgement Postcard			
<i>(Identify type of correspondence)</i>			
is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: The Assistant Commissioner for Patents, Washington, D.C. 20231 on			
12 April 2002 <i>(Date)</i>			
_____ Kristi Murray/Dorsey & Whitney LLP <i>(Typed or Printed Name of Person/Mailing Correspondence)</i>			
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